

CGX-001US (42145-20001.00)

REMARKS

Applicants thank the Examiner for his help in preparing this response. Applicants have amended claims 1, 16, 18, 20, and 23 to place them in condition for allowance and canceled claims 49-68 without prejudice. Applicants respectfully request entry and consideration of new claim 69. Support for the amendment of claim 20 is found on page 24, line 14, of the specification. Support for new claim 69 is found on page 4, lines 23-29; page 20, lines 1-8; page 31, lines 1-16; and page 22, lines 20-30 of the specification.

As requested by the Examiner Applicants have amended the title of the invention and Table 1 of the specification (attached to the amendment submitted 16 May 2003 as substitute pages 32-35). Inadvertent misspellings in Table 1 were corrected as shown in the marked-up copy of the original table. No new matter has been introduced by these amendments to the claims and specification.

TITLE

The Examiner objects to the title of the invention as not descriptive.

Applicants have amended the title of the invention to recite, "Gene Specific Arrays, Preparation and Use" and respectfully request withdrawal of the objection.

NEW MATTER

The Examiner rejects claims 49-68 under 35 USC § 112, first paragraph, as containing subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed had possession of the claimed invention. The Examiner states that the limitation residing in the word "only" is not supported in the specification.

Applicants have canceled claims 49-68; therefore, the rejection is moot.

LACK OF ENABLEMENT

The Examiner rejects claim 18 under 35 USC § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains or with which it is most nearly connected to make and/or use the invention. The Examiner states that claim 18 is not directed to generic sequences but rather to specific sequences defined by the primer pairs cited in the claim and that defined chromosomal location for each probe needs to be cited in the specification. The Examiner suggests that an amendment accompanied by a declaration by the agent would be sufficient to overcome lack of enablement.

Applicants have amended Table 1, attached to the amendment submitted 16 May 2003, as Substitute Pages 32-35. The undersigned agent, Lynn E. Murry, declares: I have amended Table 1 to include chromosomal location previously incorporated by reference. Columns 1-6 are as filed in the specification on pages 32-35; and column 7 presents the human chromosomal location for each STS/gene. In addition, the inadvertent typographical errors have been corrected as shown in the marked-up copy submitted therewith.

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The amended table contains only material that would be readily available to one of skill in the art using GenBank and the STS/gene identifier presented in Table 1 as originally filed. The GenBank references for each of the STS/gene identifiers and chromosomal locations were attached to the amendment submitted 16 May 2003. As the amendatory material consists of the same material incorporated into the specification by reference, no new matter has been introduced by the amendment of Table 1.

With this declaration and the amendment of Table 1, Applicants respectfully request the withdrawal of the rejection of claim 18 under 35 USC § 112, first paragraph.

PRIOR ART BASED REJECTIONS

The Examiner has rejected claims 1-7, 9-17, 19-22, 49-55 and 57-68 under 35 USC § 103 (a) as being unpatentable over Duggan *et al.* (1999, Nat Genet 21(S):10) in view of Schena *et al.* (1995, Science 270:467), and taken further in view of Wilcox *et al.* (NAR 19:1837). The Examiner has also rejected claims 1-17, 19-22, and 49-68 under 35 USC § 103 (a) as being unpatentable over Duggan in view of Schena taken further in view of Wilcox and taken still further in view of Fodor *et al.* (USPN 5,510,270). The Examiner states that the rejection is maintained and reiterated from the previous office action and expanded regarding STS probes.

Applicants have amended claim 1 and canceled claims 49-68. For there to be a prima facie case of obviousness, both the suggestion and expectation of success must be found in the prior art and not in Applicant's disclosure. Since none of the references individually or collectively suggest an array containing a plurality of chromosomal location-based human polynucleotides amplified using the disclosed primers, Applicants aver that the references do not render obvious the subject matter of pending claims. It could only be through the use of hindsight that one would have had the motivation to use the human polynucleotides of known chromosomal location and known disease associations to produce and use the arrays claimed herein.


Hence the Examiner has not presented a prima facie case of obviousness against pending claims 1-7, 9-17, and 19-22; and Applicants respectfully request that the rejection of claims 1-7, 9-17, and 19-22 under 35 USC §102 (f) or (g) under 35 USC § 103 (a) be withdrawn.

CONCLUSION

Applicants believe that the application is now in condition for allowance. If a phone call would expedite prosecution, the Examiner is cordially invited to call the undersigned agent at 479-973-0734. To Applicants knowledge, no fee is due with this amendment.

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